

Applicants: Oliver Nickel
Application No. 09/844,083
Amendment in Response to Office Action dated April 14, 2004

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 1-20 are pending. Amendments have been made to claims 1, 8 and 18 to overcome the rejections under 35 U.S.C. 112, second paragraph. Changes that have been made to the claims are presented above using strikethrough and underlining. It is believed that no new matter has been added.

Applicant believes the amendments have placed the above-identified application in condition for allowance, and therefore believe no stringent showing under 37 CFR §1.116 is required.

Objection to the specification

The Examiner objected to the specification for being vague and indefinite, and has required the Applicant to submit a substitute specification. In response, Applicant does not understand the Examiner's objection as the specification is not vague and definite. In fact, U.S. Patent No. 6,723,406 which is relied upon for the obviousness-type double patenting rejection, discussed infra, contains the very same terms being objected to here by the Examiner. Applicants see no reason why the terms contained in the above-identified application are deemed to be vague and indefinite when a patent, which claims related subject matter, is presumed valid. The Examiner objected to the terms such as "good adhesion" and "good absorption". Applicant submits these terms are not

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vague or indefinite as a search of the USPTO database on August 4, 2004 retrieved 17,119 patents with the term "good adhesion" and 942 patents with the term "good absorption" found in the specification of the respective patents. A copy of the first page of each search result is attached for the Examiner's convenience.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 1-20 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner found the term "composition" indefinite. In response, Applicant has amended the term to recite "layer" as suggested by the Examiner.

Regarding the remaining portions of the rejection, the Examiner found the terms "masking material", "on a side thereof", and "is capable" as being indefinite. Before addressing each one of the terms individually, as stated above, U.S. Patent No. 6,723,406 which is relied upon for the obviousness-type double patenting rejection, discussed infra, contains the same terms being objected to here by the Examiner. Therefore, Applicants see no reason why the terms contained in the above-identified application are deemed to be vague and indefinite when a patent, which claims related subject matter, is presumed valid.

The Examiner found the term "masking material" vague and indefinite, because the term allegedly lacks any inherent structural element. In response, Applicant point out that even though the phrase "masking material" standing alone could possibly be viewed as vague and indefinite, this is not in fact how the phrase is being used. When read in light of its relation to the other elements of claim 1, the masking material is

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provided with sufficient structure and relation thereto such that the masking material is "laminated in an edge region of the pressure-sensitive adhesive composition" and the masking sheet covers "the masking material on a side thereof". A person skilled in the art would be able to determine the relationship of the masking material to the pressure-sensitive adhesive composition and the masking sheet so as to provide sufficient clarity and definiteness as to its structure, and would thereby exclude those materials that would not comply with the relationship as presently claimed.

It would appear the Examiner would prefer a different term in place of "masking material". Applicant refer the Examiner to MPEP 2173.02 which recites in part:

When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Thus, Applicant would consider alternative language presented by the Examiner presuming the desired scope of the claim is not unduly narrowing.

The Examiner found the term "on a side thereof" to lack antecedent basis, i.e.-

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the Examiner was unclear as to the scope of the term. Applicants do not believe there is an antecedent problem as the term "on a side thereof" is clear on its face in its relation to the claim, wherein the term refers to a side of the masking material.

The Examiner found the term "is capable" of being indefinite, but does not give any particular reason why its use renders the claims containing it indefinite. In response, Applicant points out functional language "does not, in and of itself, render a claim improper", and the language must be evaluated as to what is conveyed to a person of ordinary skill in the art. See *MPEP* 2173.05(g). Moreover, Applicant respectfully disagrees that it is not a limitation since materials incapable of performing the stated function are thereby excluded. Also, Applicant submits the term is an art-recognized term, wherein a search of the USPTO website database on August 5, 2004 revealed 194,162 patents, including 133 patents related to tapes, where the term 'is capable' is found in the claims. A copy of the first page of the search results is enclosed for the Examiner's reference. Clearly, the term is commonly used in a variety of different arts, and has been accepted by the Patent Office itself.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

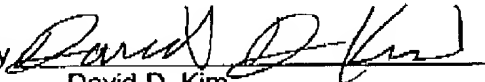
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Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By 
David D. Kim
Reg. No. 53,123

220 East 42nd Street
30th Floor
New York, New York 10017

- Enclosures:
- (1) Copy of first page of USPTO website search result for "good adhesion"
 - (2) Copy of first page of USPTO website search result for "good absorption"
 - (3) Copy of the first page of USPTO website search result for "is capable" in all patents
 - (4) Copy of the first page of USPTO website search result for "is capable" in "adhesive tape"-related patents
 - (5) Copy of terminal disclaimer over USSN 09/844,084,
 - (6) Stamped postcard indicating receipt of terminal disclaimer over USSN 09/844,084

Patent Database Search Results: ACLM/"is capable" AND ABST/"adhesive tape" in 1976... Page 1 of 2

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Searching 1976 to present...

Results of Search in 1976 to present db for:

ACLM/"is capable" AND ABST/"adhesive tape": 133 patents.

Hits 1 through 50 out of 133

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ACLM/"is capable" AND ABST/"adhesive tape"

PAT. NO.	Title
1 6,723,406	T Masking tape and its use
2 6,719,031	T Device for cutting out an article from a long tape and adhering the article to an adhesive tape
3 6,676,065	T Web winding method and apparatus therefor
4 6,662,844	T Adhesive tape dispenser with anti-reverse roll rotation capability
5 6,645,591	T Components for countertop assembly and fabrication
6 6,645,042	T Backless, strapless bra with swivel snap system
7 6,641,910	T Stretch releasing adhesive tape with segmented release liner
8 6,641,096	T Stretch releasing adhesive tape article with bundling strap
9 6,631,839	T Holder for business cards
10 6,627,031	T Tagging material method and means for applying tagging material
11 6,612,474	T Hand-held tape dispenser with brake mechanism
12 6,585,023	T Tape application apparatus
13 6,576,575	T Dispersible, adherent article
14 6,569,521	T Stretch releasing pressure sensitive adhesive tape and articles
15 6,508,287	T Adhesive tape applicator for the door sash frame of an automobile
16 6,485,106	T Size adjustable wheel rim masks
17 6,403,206	T Removable foam adhesive tape
18 6,398,619	T Party streamer dispenser
19 6,395,389	T Adhesive tape strip
20 6,386,415	T Adhesive tape feeding apparatus for feeding tape automatically after cutting

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Results of Search in 1976 to present db for:

ACLM/"is capable": 194162 patents.

Hits 1 through 50 out of 194162

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[Refine Search](#) ACLM/"is capable"

- | PAT.
NO. | Title |
|--------------|--|
| 1 6,772,436 | T <u>Interactive audio conferencing system</u> |
| 2 6,772,394 | T <u>Internet television device capable of selecting hot spots by the use operation buttons</u> |
| 3 6,772,385 | T <u>Error-correcting device and decoder enabling fast error correction with reduced circuit scale</u> |
| 4 6,772,355 | T <u>System and method for reducing power consumption in a data processor having a clustered architecture</u> |
| 5 6,772,353 | T <u>Computer interface architecture having a power saving function</u> |
| 6 6,772,347 | T <u>Method, apparatus and computer program product for a network firewall</u> |
| 7 6,772,338 | T <u>Device for transferring data between an unconscious capture device and another device</u> |
| 8 6,772,329 | T <u>SCSI phase specific bus reset generator</u> |
| 9 6,772,274 | T <u>Flash memory system and method implementing LBA to PBA correlation within flash memory array</u> |
| 10 6,772,272 | T <u>Apparatus and method for writing information to a designated information storage medium with an allocated data storage device using a specified information recording format</u> |
| 11 6,772,256 | T <u>Routing arbiter for data network switching</u> |
| 12 6,772,246 | T <u>PCI riser card bracket assembly</u> |
| 13 6,772,229 | T <u>Centrifugal communication and collaboration method</u> |
| 14 6,772,222 | T <u>Multicast forwarding table processor</u> |
| 15 6,772,219 | T <u>Message relaying scheme based on switching in units of flows</u> |
| 16 6,772,216 | T <u>Interaction protocol for managing cross company processes among network-distributed applications</u> |

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Results of Search in 1976 to present db for:

SPEC/"good adhesion": 17119 patents.

Hits 1 through 50 out of 17119

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SPEC/"good adhesion"

- | PAT.
NO. | Title |
|--------------|---|
| 1 6,772,012 | T Methods for electrosurgical treatment of spinal tissue |
| 2 6,770,978 | T Metal line, method for fabricating the metal line, thin film transistor employing the metal line and display device |
| 3 6,770,977 | T Semiconductor device and method for fabricating the same |
| 4 6,770,954 | T Semiconductor device with SI-GE layer-containing low resistance, tunable contact |
| 5 6,770,702 | T Polymer |
| 6 6,770,686 | T Photocationic initiator combinations |
| 7 6,770,567 | T Method of reducing particulates in a plasma etch chamber during a metal etch process |
| 8 6,770,556 | T Method of depositing a low dielectric with organo silane |
| 9 6,770,531 | T Adhesive material for programmable device |
| 10 6,770,379 | T Susceptor for semiconductor manufacturing equipment and process for producing the same |
| 11 6,770,357 | T Precoated skin material for automobile interior part |
| 12 6,770,352 | T Film provided with hardcoat and process for producing the same |
| 13 6,770,225 | T Textured retroreflective prism structures and molds for forming same |
| 14 6,770,176 | T Apparatus and method for fracture absorption layer |
| 15 6,770,071 | T Bladed electrosurgical probe |
| 16 6,770,004 | T Electrically conductive timing belt |
| 17 6,769,969 | T Raised island abrasive, method of use and lapping apparatus |
| 18 6,769,618 | T Wallet card with a magnifying lens and light |
| 19 6,769,424 | T Heater with heat resistant anti-oxidant coating on interior surfaces |

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Searching 1976 to present...

Results of Search in 1976 to present db for:

SPEC/"good absorption": 942 patents.

Hits 1 through 50 out of 942

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SPEC/"good absorption"

- | PAT.
NO. | Title |
|--------------|--|
| 1 6,770,787 | <u>T Heavier halogen atom substituted squaraine based dyes, process for the preparation thereof and use thereof as sensitizers for photodynamic, therapeutical and industrial applications</u> |
| 2 6,770,299 | <u>T Lipid matrix-drug conjugates particle for controlled release of active ingredient</u> |
| 3 6,767,597 | <u>T Ink jet recording medium</u> |
| 4 6,762,124 | <u>T Method for patterning a multilayered conductor/substrate structure</u> |
| 5 6,759,804 | <u>T Illumination device with at least one LED as light source</u> |
| 6 6,759,020 | <u>T Spark-ignited internal combustion engine oxide gas absorbing arrangement and method</u> |
| 7 6,758,211 | <u>T Transparent thermal insulation device</u> |
| 8 6,755,443 | <u>T Packaging element with printed marking, use thereof and method for making same</u> |
| 9 6,746,635 | <u>T Methods for micronization of hydrophobic drugs</u> |
| 10 6,740,293 | <u>T Housing for test strip device and test strip therefor</u> |
| 11 6,737,237 | <u>T Antimicrobial agents, diagnostic reagents, and vaccines based on unique Apicomplexan parasite components</u> |
| 12 6,734,631 | <u>T Low-pressure gas discharge lamp with phosphor coating</u> |
| 13 6,729,711 | <u>T Ink jet recording apparatus</u> |
| 14 6,727,345 | <u>T Continuous production process for water-absorbent resin powder and powder surface detector used therefor</u> |
| 15 6,726,783 | <u>T High storage capacity alloys having excellent kinetics and a long cycle life</u> |
| 16 6,723,406 | <u>T Masking tape and its use</u> |
| 17 6,719,985 | <u>T Cosmetic material containing crystalline superfine silk powder</u> |

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